

Patent Appl. No. 10/016,850
REPLY TO OFFICE ACTION OF MAY 21, 2007

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ARGUMENT

Appellants are in receipt of the Office Action mailed May 21, 2007 in this matter, and have the following comments thereupon.

Rejection of claims 11-6,8,9, 11, 12, 14-16 and 24-26 pursuant to 35 U.S.C. §103(a).

The Examiner has again rejected pending claims 1-6, 8, 9, 11, 12, 14-16 and 24-26 as allegedly unpatentable under 35 U.S.C. § 103(a) over the combination of DeSantis (U.S. Patent Publication 2001/0047012) and Collins et al., (WO 01/92288). Applicants traverse this rejection.

Applicants hereby incorporate by reference the arguments advanced in the Appeal Brief filed October 13, 2006, and the Request for Continued Prosecution (RCE) filed April 18, 2007, as well as the comments made by Dr. Patrick Hughes in his Declaration, also filed October 13, 2007 and April 18, 2007. In addition, Applicants have the following comments.

In the most recent Office Action of May 21, 2007 (the "Office Action") the Examiner has identified the person of ordinary skill in the art ("POSTI") as being "of skill in the art of formulation chemistry who seeks a pharmaceutical conjugate comprising a therapeutic component and an efficiency enhancing component of instant formula A" Office Action at page 3. This manner of conceiving the hypothetical POSTI clearly relies on prior knowledge of the Applicants' own patent

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specification as the basis for a finding of obviousness, and therefore comprises a hindsight "construction" of the invention based on the present specification.

Hindsight reconstruction has long been forbidden. As stated by the United States Supreme Court, "[a] factfinder should be aware . . . of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. *KSR International Co. v. Teleflex Inc.*, ___ U.S. ___ (2007), slip op. at 17. (quoting *Graham v. John Deere*, 383 U.S. 1, 36 (1966), which warned against a "temptation to read into the prior art the teachings of the invention in issue" and instructed courts to "guard against slipping into the use of hindsight".

The Examiner uses this hindsight analysis in an attempt to "bootstrap" the remainder of the obviousness analysis. As stated in previous replies, DeSantis et al. discuss methods of treatment involving combining two or more separate compounds; a) a glutamate antagonist and b) an IOP (intraocular pressure) controlling agent, for the treatment of glaucoma or ocular hypertension. DeSantis et al. nowhere discuss pharmaceutical conjugates comprising an efficiency enhancing component having the structure of formula A, and a therapeutic component. Indeed, DeSantis et al. do not disclose efficiency enhancing components at all. Nor do DeSantis et al. chemical conjugates.

Collins et al. appears to be cited by the Examiner to show that chemical conjugates are known. However, Collins does not disclose the treatment of ocular hypertension or diseases of the retina or posterior segment.

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While the Examiner admits that the Declaration of Patrick M. Hughes, Ph.D. provides evidence that the claimed compositions are "delivered to the posterior segment of the eye in an amount several folds [sic] that delivered to the anterior segment of the eye", Office Action at page 4, the Examiner dismisses this as simply "another advantage of a known composition". *Id.* The Examiner then cites *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977), which stands for the proposition that "claiming of a new use, new function or unknown property [of an old composition] which is inherently present in the prior art does not necessarily make the claim patentable." See MANUAL OF PATENT EXAMINING PROCEDURE, §2112(I) (emphasis added).

Accordingly, Applicants respectfully submit that it is impossible to point to any "known composition" that is both claimed in the present patent application and present in either or both DeSantis or Collins. Without such a compound both in the prior art and claimed in the present patent application there can be no inherency.

The present invention is not drawn to a method of treatment using separate compounds. Rather the invention comprises single molecules never before described and compositions containing these agents. Nothing in the combination of Desantis and Collins renders such compositions obvious.

The Office Action also states that the terms "therapeutic component" and "efficiency enhancing component" are "intended uses", and as such "confer no patentable weight to the composition claims. Respectfully, Applicants are entitled to be

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their own lexicographers and may define these terms in any manner not repugnant to their ordinary meaning.

The Examiner's position is contrary with the actual words of the specification in describing these terms as intended uses. For Example, the specification at page 1 indicates that the term therapeutic component (or "TC") as any chemical entity which is effective to act on or bind to a receptor and produce a therapeutic effect. Examples of TCs are provided in pages 5-10 of the specification. Moreover, claims 7, 8, and 24-26 are drawn to particular therapeutic components.

Similar the term "efficacy enhancing component" is defined in each pending claim with reference to its chemical structure.

Thus, each of these terms have a clearly indicated meaning in the claims, and any assertion otherwise is contrary to the evidence.

The Office Action also has dismissed the Declaration and arguments apparently without any meaningful consideration. For example, the Examiner states that differences in function between the claimed composition and those of the prior art are irrelevant to the issue of obviousness because the pending claims are composition. Applicants strenuously beg to differ.

First, while Applicants do not believe that the present invention is even *prima facie* obvious over DeSantis and Collins, the Declaration evidence was provided as rebuttal evidence sufficient to overcome even such a *prima facie* case of obviousness. The evidence shows, as the Examiner admits, the

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claimed compositions are "delivered to the posterior segment of the eye in an amount several folds [sic] that delivered to the anterior segment of the eye", Office Action at page 4. These results are therefore surprising and completely unanticipated in light of the prior art. And surprising results are one of the "secondary considerations" showing non-obviousness first enunciated under *Graham v. John Deere*.

Furthermore, the Examiner's failure to give meaningful consideration to the Declaration of Dr. Hughes is contrary to the August 29, 2007 decision of Court of Appeal for the Federal Circuit *In re John B. Sullivan and Findlay W. Russell*, ___ F.3d ___, ___ USPQ2d ___ (case number 2006-1507) (Fed. Cir. August 29, 2007). In *Sullivan* the court held that when "the Director argues that . . . evidence [of surprising results] only relates to use of an obvious composition, that is incorrect". Whether the composition would have been obvious cannot be determined without considering evidence attempting to rebut the prima facie case." *Id.* at 10 (emphasis added).

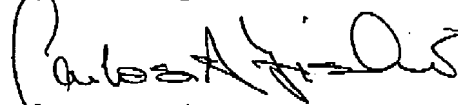
As has been clearly discussed in prior Replies, the Applicants have demonstrated in their Declaration that the claimed compositions, which have been described in none of the prior art cited by the Examiner, have a surprising and unexpected advantage for treatment of disorders of the posterior segment of the eye. Therefore these novel composition are not obvious, and Applicants respectfully request that the claims be passed to issue.

Applicants hereby authorize the Director to use Deposit Account 50-4004 for payment of a two month's Extension of the

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Time to reply to the Examiner's Answer. If any other fee is due, Applicants hereby authorize the Commissioner to use Deposit Account 01-0885 for the payment of such fee.

Respectfully submitted,



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